

***Advisory Action  
Before the Filing of an Appeal Brief***

**Application No.**

10/758,115

**Examiner**

BRIAN P. WHIPPLE

**Applicant(s)**

SUSHIMA ET AL.

**Art Unit**

2452

***--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --***

**THE REPLY FILED 29 October 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.**

1.  The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

a)  The period for reply expires 3 months from the mailing date of the final rejection.  
 b)  The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
 Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2.  The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3.  The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
 (a)  They raise new issues that would require further consideration and/or search (see NOTE below);  
 (b)  They raise the issue of new matter (see NOTE below);  
 (c)  They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
 (d)  They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4.  The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5.  Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.

6.  Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7.  For purposes of appeal, the proposed amendment(s): a)  will not be entered, or b)  will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: \_\_\_\_\_.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8.  The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9.  The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fail to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10.  The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11.  The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
 See Continuation Sheet

12.  Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.

13.  Other: \_\_\_\_\_.

/THU NGUYEN/  
 Supervisory Patent Examiner, Art Unit 2452

11/10/09  
 /B. P. W./  
 Examiner, Art Unit 2452

Continuation of 11. does NOT place the application in condition for allowance because: the amendment has not been entered due to non-compliance and therefore the 35 USC 112 rejection cannot be overcome. Additionally, the proposed amendment would not overcome the 35 USC 112 rejection, because the Examiner cannot find antecedent basis for "said configuration information retention unit." There is a phrase directed to "a conversion information retention unit" earlier in claim 5 or "a system configuration retention database" in claim 1, but the Examiner cannot find the exact phrase used in claim 5.

Applicant argues Albert fails to disclose storing system configuration information that is information on services required for configuring the information processing system including information on the type of services to be executed and information on server performance and the number of servers required for each service. In response to Applicant's argument that the references fail to show a certain feature of Applicant's invention, it is noted that the feature upon which Applicant relies (i.e., "information on server performance") is not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to Applicant's argument that Albert fails to disclose "a system configuration information retention database for retaining system configuration information including information about necessary configuration of each server module for execution of said service and the number of server modules to which said service is to be assigned, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In the instant case, the language following the two uses of the word "for" may be interpreted as intended use of the system configuration information retention database. A computer with such a database (as disclosed by Albert in the cited sections discussed in the remarks and previous Office action) would be capable structurally of storing a variety of information, including that listed by Applicant, and therefore the prior art structure is capable of performing the intended use.

Applicant argues Albert fails to disclose a storage device for storing a service to be executed by said server modules. However, similarly to the discussion above, the storage device recites an intended use that the prior art structure is capable of performing. Applicant also argues Albert fails to disclose assigning services to the servers in accordance with a result of comparison between system configuration information stored in the server and configuration information sent by the servers. The Applicant states Col. 13, ln. 16-21 of Albert fail to disclose this, but the Examiner relied upon Col. 13, ln. 16-18; Col. 3, ln. 33-38; and Col. 8, ln. 63 - Col. 9, ln. 2.

Additionally, in response to Applicant's arguments against the references individually (i.e., Official Notice was relied upon to reject portions of the argued limitation), one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant argues Albert fails to disclose server modules, each of which has a configuration transmission unit that transmits configuration information about its own server modules. Similarly to above, transmitting configuration information about each of the server modules is intended use. Additionally, Albert discloses server modules comprising a configuration information transmission unit (Col. 6, ln. 66 - Col. 7, ln. 4). Each server is in communication with a forwarding agent. Additionally, by necessity, the server must include modules such as software/firmware and hardware such as transmission ports that transmit configuration information of the server in order to enable networked communication.

Applicant's traversal of the Official Notice is inadequate. MPEP 2144.03 (C) states in part: "To adequately traverse such a finding, an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR 1.111(b)." The Examiner maintains that providing a unique host name in accordance with response information meets the requirement for "the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known."